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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,483	10/18/1999	TAKEO INAGAKI	IDE61601	4400

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21

EXAMINER

ZIMMER, MARC S

ART UNIT PAPER NUMBER

1712

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/367,483

Applicant(s)

INAGAKI ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Specification

The objection to the concept of a "binding region" is hereby withdrawn in view of Applicant's definition provided on page 4 of Applicant's response dated November 30, 2001. (Subsequently, the Examiner stated on page 2 of paper no. 12 that this phrase ostensibly referred to the extent of crosslinking of the gel but Applicant has not commented on the Examiner's interpretation of this aspect of the invention.)

In the amended paragraph that replaces the paragraph bridging pages 7 and 8 of the original disclosure, Applicant, once again, makes reference to a "binding agent" despite the Examiner's contention that new matter is introduced with the disclosure of this concept. Applicant first introduced the offending phrase in their response dated April 30, 2001 as a *replacement* for the phrase, "binding region". In the Examiner's next Office action dated May 25, 2001, the Examiner explained that the replacement of "binding region" with "binding agent" did nothing but further convolute matters because it suggested that a chemical ingredient other than the base silicone polymer, crosslinking agent and catalyst was present in the polymer system. Since that time, the phrase "binding agent" has been removed and then inexplicably reincorporated into the Specification. Furthermore, it is peculiar that the amended paragraph at the aforementioned location now contains reference to both a binding region and a binding agent as though they are now representative of different concepts since the latter was originally intended to replace the former. **Applicant is required to remove each and every mention of a binding agent from the Specification when responding to this Office action.**

As an aside, it is notable that Applicant has taken the Examiner's suggestion regarding the removal of all reference to a binding region in claim 1 but continues to use that description in both the Specification and in claim 7. The Examiner submits that a simple approach to addressing the confusion surrounding the disclosure of a binding region would be to amend the Specification and claim 7 in a manner consistent with the changes made in claim 1. That is, claim 7 could be amended such that it states that said composition is caused to undergo an addition reaction that crosslinks the silicone to the extent that a gel having a low crosslink density is produced. A similar change to the paragraph bridging pages 7 and 8 is also suggested.

Claim Rejections - 35 USC § 112

The § 112, second paragraph rejection of claims 1 and 7-9 is hereby withdrawn in view of Applicant's remarks.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has asserted that the adjusting step is now sufficiently defined in the claims so as to overcome the Examiner's rejection based on the idea that the adjusting

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step was not enabled. The Examiner disagrees. On the one hand, claim 1 states that the adjusting step entails crosslinking the silicone gel (lines 7 and 8 of the claim). At the same time, Applicant refers the Examiner to the paragraph bridging pages 8 and 9 wherein the refractive index is said to be adjusted *in advance*. Likewise, the description in the paragraph bridging pages 11 and 12 also supports the notion that the adjusting step takes place prior to crosslinking the polymer. The Examiner hypothesized in paper no. 12, page 4 that the italicized term indicates that the refractive index is controlled by judicious selection of an unvulcanized silicone having a number of aryl groups high enough to impart the desired level of refraction. It was further emphasized that, if the adjusting step did merely involve choosing a polysiloxane having a satisfactorily high number of aryl groups, there was no support for this in the Specification. (Applicant confirmed that this was indeed the case on page 4 of their response dated August 27, 2002.) The description of the adjusting step in the claims is not consistent with that provided in the Specification. Therefore, the Specification is not enabling for the claimed adjusting step.

It is further noted that Applicant now states in the amended paragraph bridging pages 7 and 8 that said adjusting step is known. Are they alluding to the selection process taught by the references? Ultimately, the record is still unclear as to what the adjusting step involves, especially given the conflicting disclosure in the claim(s) and Specification.

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Allowable Subject Matter

If Applicant somehow identifies a solution to the ongoing enablement problem, claims 1 and 7-9 could be found allowable. The Examiner still has not found prior art that motivates one of ordinary skill to prepare the silicone gels taught by *Filas* and *Suzuki* in a clean room.

This is a continuation of applicant's earlier Application No. 09/367483. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

July 2, 2003

A handwritten signature in cursive script that reads "Robert A. Dawson".

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700